



PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Application No. : 09/862,502 Confirmation No.: 7223
Applicant : Gerhard Dittrich
Filed : May 23, 2001
Title : METHOD FOR PROVIDING MEASURED VALUES
FOR END CUSTOMERS
TC/A.U. : 3621
Examiner : C.O. Sherr
Docket No. : DITT3001 /FJD
Customer No. : 23364

BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22202-3514

Sir:

INTRODUCTORY COMMENTS

Pursuant to the provisions of 37 CFR 41.37, submitted herewith is Applicant/Appellant's Brief on Appeal. The period for response has been extended to December 26, 2007 by filing a Petition for a One Month Extension of Time and payment of the required fee.

REAL PARTY IN INTEREST

(37 CFR 41.37(c)(1)(i))

The real party in interest is Applicant/Appellant's assignee Endress + Hauser GmbH + Co. The assignment was recorded on May 23, 2001 at Reel 011839 and Frame 0101.

RELATED APPEALS AND INTERFERENCES

(37 CFR 41.37(c)(1)(ii))

There are no related appeals or interferences with respect to the invention defined in this application.

STATUS OF CLAIMS

(37 CFR 41.37(c)(1)(iii))

This application contains claims 1 - 29.

Claims 1 - 7 have been cancelled.

Claims 8-29 have been finally rejected and are on appeal.

STATUS OF AMENDMENTS

(37 CFR 41.37(c)(1)(iv))

A Request for Reconsideration was filed on August 23, 2007, after issuance of the final Office Action of May 23, 2007. In response to this Request, the examiner issued an Advisory Action, dated October 3, 2007 maintaining the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

(37 CFR 41.37 (c)(1)(v))

(References are to page and line of the specification)

The invention relates to a method for providing measured values for end customers, (pg. 1, lines 3 and 4). In process automation, field transmitters are widely used which regulate or control process cycles in production plants, (pg. 1, lines 6-8). Generally field transmitters are connected to a process control system by means of a data link, (pg. 1, lines 22-25).

The data link is used to forward the measured values supplied by a sensor to the process control system, (pg. 1, lines 30-32).

According to the method, a measured value is recorded using a sensor. This measured value is transmitted to a process control system. The number of transmission operations is counted and the cost to the end customer are calculated on the basis of the number of transmission operations, (pg. 3, line 12-22).

As noted in the example of Fig. 2, a process variable is measured by a pick-up MWA. This measured value is digitized in an A/D converter. The measured value pick-up MWA and the AD converter are connected to one another by a data line DL5'. The measured value is forwarded from the A/D converter to a computer unit RE over a data line DL4'. The computer unit RE transfers stored measured values either cyclically or at the request of the process control system PLS to a communications unit KE over data line DL3'. The communications unit KE converts the measured values into a telegram which is passed to the data bus line DBL over a data line DL2' and via a field bus interface FB52, (pg. 5, lines 19-31).

The telegram contains the digitized measured value as well as information relating to the transmitter and to the receiver in the form of data bus addresses DA which uniquely identify each data subscriber, (pg. 5, lines 36-38 to pg. 6, lines 1 and 2). If, for example, the process control system PLS sends a telegram to the temperature sensor S1, then the data bus address of the temperature sensor S1 is the receiver address, and the data bus address of the process control system PLS is the sender address, (pg. 6, lines 8-13).

Independent claim 8 defines the method of providing the measured values to the end customer, and independent claim 26 defines the method for selling the measured values to the end customers.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL
(37 CFR 41.37(c)(1)(vi))

Claims 8-29 are finally rejected under 35 U.S.C. 103 (a) as unpatentable over Shimura in view of Budicke, Jr. and Mulokey et al.

ARGUMENT
(37 CFR 41.37(c)(1)(vii))

(1)

The inventive method provides measured values to end customers. The measured values are obtained by sensors. The sensors measure the particular value and transmit this particular value (measured value) to a control system. The number of transmissions is recorded and the costs associated with the number of transmissions is calculated for the end customer.

The method disclosed and claimed addresses and solves a problem which has arisen in the field whereby end customers have found themselves paying for sensors regardless of how extensively the sensors were used to provide measured values. By calculating the number of transmissions, the end customer is responsible only for the usage.

It should first be noted that the references cited by the examiner do not address the problem faced by the end customers and outlined above. Problem recognition is missing, and that alone could be fatal to a rejection under 35 USC 103, See, **KSR International Co. v. Teleflex Inc.** (US Sup. Ct., 2007), 82 USPQ2d 1385. Common sense is paramount to the analysis, *Id.*

(2)

Considering each reference specifically, and then in combination, **Shimura** does not consider "the costs for the end customer on the basis of the number of transmission operations" as noted by the examiner in enumerated paragraph 14 on page 5 of the Office Action of May 23, 2007. Instead the examiner suggests that Budike, Jr. discloses "calculating the costs for the end customer" in col. 7, beginning with line 25 to col. 8, line 55. This passage referred to by the examiner does mention the use of sensors to "obtain utility meter activity," which sensors "may be connected to the central processing unit." Regarding the associated program, this passage states in col. 8, "the

program reduces consumption without shutting down vital equipment by identifying and warning of individual utility consuming equipment and consumption rate changes, by anticipating peak loads, and by anticipating demand spikes and sags, and then initiating a second control protocol and algorithm to the appropriate control system to automatically correct or eliminate inefficient energy consumption.” What, it is respectfully submitted, does this program have to do with the invention disclosed and claimed in this application? It is respectfully submitted that it has in fact very little to do with the invention disclosed and claimed. It does not teach counting the number of transmission operations, and even if it did, it is not clear and would not, it is respectfully submitted be clear to the person of ordinary skill in the art. One cannot justify a combination of teachings when the teaching of at least one reference in the combination is not clear. On this point, the examiner states on page 5 of the Office Action of May 23, 2007 that “.....official notice is taken that counting the number of operations is old, well known and necessary and anything having to do with monitoring and accounting as occurs in both Budike and Shimura.” From an evidentiary point of view, such a position is unwarranted. See, **Brand v. Miller**, 82 USPQ2d 1705 (CAFC 2007). While this decision refers to the Board of Patent Appeals and Interferences, it could just as easily be applied to patent examination. The record in this prosecution must include evidence sufficient to make a prima facie case and not be based on what the examiner perceives as a possible reality. The fact that “counting” may be old does not mean that counting the number of transmission operations in the context of the claimed invention is either old or obvious.

Mulokey et al does not change this conclusion. Counting clocks bits does not, it is respectfully submitted, amount to calculating the number of transmission operations and calculating the costs to the end customer.

It is respectfully submitted, that a prima facie case has not been made by the combination suggested by the examiner, so that claims 8 - 29 should be allowed.

CONCLUSION

In view of the above, it is respectfully submitted that claims 8-29 should be allowed over the references of record and those applied.

Respectfully submitted
BACON & THOMAS, PLLC

Date: December 26, 2007


Felix J. D'Ambrosio
Reg. No. 25,721

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, VA 22314
Tel: (703) 683-0500
Fax: (703) 683-1080

S:\Producer\jfd\CLIENTS\Endress+Hauser Holding GmbH\DTT3001 - EH0423\Appeal Brief Dec 26 2007.wpd

APPENDIX OF CLAIMS
(37 CFR 41.37 (c)(1)(viii))

Claims 1-7 (Cancelled)

8. A method for providing a measured values for end customers, comprising the steps of:

recording a measured value for a process variable using a sensor S1, S2, S3;

transmitting the measured value to a process control system PLS;

counting the number A of transmission operations; and

calculating the costs for the end customer on the basis of the number A of the transmission operations.

9. The method as defined in claim 8, wherein the data transmission between sensor S1, S2, S3 and the process control system PLS takes place in line-conducted fashion, using, for example, a data bus system DBS.

10. The method as defined in claim 8, wherein the data transmission between sensor S1, S2, S3 and the process control system PLS takes place by radio.

11. The method as defined in claim 8, wherein the number A is stored in the sensor S1, S2, S3.

12. The method as defined in claim 9, wherein the number A is stored in the sensor S1, S2, S3.

13. The method as defined in claim 10, wherein the number A is stored in the sensor S1, S2, S3.

14. The method as defined in claim 8, wherein the number A is stored in process control system PLS.

15. The method as defined in claim 9, wherein the number A is stored in process control system PLS.

16. The method as defined in claim 8, wherein the measured values are transmitted over the internet from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

17. The method as defined in claim 9, wherein the measured values are transmitted over the internet from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

18. The method as defined in claim 10, wherein the measured values are transmitted over the internet from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

19. The method as defined in claim 11, wherein the measured values are transmitted over the internet from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

20. The method as defined in claim 12, wherein the measured values are transmitted over the internet from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

21. The method as defined in claim 8, wherein the measured values are transmitted by radio from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

22. The method as defined in claim 9, wherein the measured values are transmitted by radio from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

23. The method as defined in claim 10, wherein the measured values are transmitted by radio from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

24. The method as defined in claim 11, wherein the measured values are transmitted by radio from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

25. The method as defined in claim 12, wherein the measured values are transmitted by radio from the sensor S1, S2, S3 to a database at the field transmitter manufacturer, to which data base at the end customer likewise has access over the internet, and wherein the number of database access operations by the end customer to this database is counted.

26. A method for selling measured values to end customers, comprising the steps of:

recording a measured value for a process variable using a sensor S1, S2, S3;
transmitting the measured value to a process control system PLS;
counting the number A of transmission operations; and
calculating the costs for the end customer on the basis of the number A of the transmission operations.

27. The method as defined in claim 8, wherein the recorded measured value for the process variable is stored in the sensor used to record the measured value.

28. The method as defined in claim 27, wherein the number A of the transmission operations stored in the sensor used to record the measured value is counted in the sensor.

29. The method as defined in claim 8, wherein the number A of the transmission operations is counted in the process control system PLS.

U.S. Pat. Appl. 09/862,502

EVIDENCE APPENDIX

There is no evidence being relied upon which was submitted pursuant to 37 CFR 1.130, 1.131 or 1.132.

U.S. Pat. Appl. 09/862,502

RELATED PROCEEDINGS APPENDIX

There is no related proceeding being relied upon.

S:\Producer\jfd\BRIEFS\Sample Brief.wpd